

REMARKS

In the Office Action of June 10, 2004, the Examiner:

- Refused to grant the benefit of priority due to the failure to disclose the instantly claimed invention in the priority document in such a manner as to comply with the requirements of the first paragraph of 35 U.S.C. §112
- Objected to the specification for informalities
- Rejected claims 1 and 4-15 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention
- Rejected claims 1 and 4-15 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor at the time the application was filed has possession of the invention
- Rejected claims 1 and 4-15 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter
- Rejected claims 1, 4 and 5 under 35 U.S.C. 102(a) and 102(e)(2) as being anticipated by Platt (US 5784294)

Under this amendment, claims 1, 4-15 and 31-35 are pending in this application. Claims 1 and 4-15 have been amended to more particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant submits that the amendments curing informalities are not being made for purposes of patentability. Claims 31-35 have been added. No new matter has been added by virtue of this amendment to the claims. For the reasons below, Applicant respectfully requests entry of the amendment and reconsideration of the pending claims.

Refusal of Grant of Priority

The Examiner refused to grant the benefit of priority due to the failure to disclose the instantly claimed invention in the priority document in such a manner as to comply with the requirements of the first paragraph of 35 U.S.C. §112. The Applicant has amended the specification (see amendment to specification above) to delete the claim of priority contained in the first paragraph of the Applicant's patent application. Therefore, the Applicant respectfully requests withdrawal of the Examiner's refusal.

Objection to the Specification

The Examiner objected to the specification for informalities. The Examiner stated that FIG. 6 is not described in the Brief Description of the Drawings. The specification has been amended to include such a description (see amendment to specification above). The Examiner also objected to the abstract of the disclosure because it is longer than 150 words. The specification has been amended to include an abstract that is less than 150 words (see amendment to specification above). Therefore, the Examiner's objection has been overcome and Applicant respectfully requests withdrawal of the Examiner's objection.

Rejection under §112 Second Paragraph

The Examiner rejected claims 1 and 4-15 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner maintained his rejection of claims 1 and 4-15 under 35 U.S.C. §112, second paragraph, as outlined in the previous Office Action of January 27, 2003. With respect to this rejection, the Applicant maintains his response to this rejection, as outlined in the Supplementary Appeal Brief of March 12, 2004.

In the Examiner's new rejections under 35 U.S.C. §112, second paragraph, starting on page 4 of the Office Action, the Examiner states that there is insufficient antecedent basis for the term "the descriptor vector" in claim 1. Claim 1 has been amended to cure this error (see amendment to claims above). The Examiner further states that the use of the differing terms "F-distributed" and "F distributed" in claim 6 is vague and indefinite. Claim 6 has been amended to

cure this error (see amendment to claims above).

The Examiner further states that certain symbols of claim 8 lack definitions and are vague and indefinite. Claim 8 has been amended to cure this error (see amendment to claims above). The Examiner further states that the use of the term “said statistic” in claims 11 and 12 causes the claims to be vague and indefinite. Claims 11-12 have been amended to cure this error (see amendment to claims above).

The Examiner further states that the use of the term “represents” in claim 12 is indefinite. Applicant respectfully disagrees with the Examiner. The term “represent” means “to stand for” or “to symbolize.” In the context of a mathematical equation, as in claim 12 and claims 8-9, the phrase “ ‘x’ represents a value” simply means that the given variable or symbol represents another value or concept. The specification uses the term “represent” in such a way in various places, such as at page 7 lines 5-7 and page 9 lines 10-12.

Therefore, the Examiner’s rejections have been overcome and Applicant respectfully requests withdrawal of the Examiner’s rejections.

Rejection under §112 First Paragraph

The Examiner rejected claims 1 and 4-15 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor at the time the application was filed has possession of the invention. The Examiner maintained his rejection of claims 1 and 4-15 under 35 U.S.C. §112, first paragraph, as outlined in the previous Office Action of January 27, 2003. With respect to this rejection, the Applicant maintains his response to this rejection, as outlined in the Supplementary Appeal Brief of March 12, 2004.

Therefore, the Examiner’s rejections have been overcome and Applicant respectfully requests withdrawal of the Examiner’s rejections.

Rejection under §101

The Examiner rejected claims 1 and 4-15 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Examiner maintained his rejection of

claims 1 and 4-15 under 35 U.S.C. §101, as outlined in the previous Office Action of January 27, 2003. With respect to this rejection, the Applicant maintains his response to this rejection, as outlined in the Supplementary Appeal Brief of March 12, 2004.

Therefore, the Examiner's rejections have been overcome and Applicant respectfully requests withdrawal of the Examiner's rejections.

Rejection under §102

The Examiner rejected claims 1, 4 and 5 under 35 U.S.C. 102(a) and 102(e)(2) as being anticipated by Platt (US 5784294). The Applicant respectfully disagrees.

This rejection should be withdrawn because the Examiner has not shown that amended claim 1 is anticipated by Platt. Nowhere does Platt teach or disclose any of the elements of amended claim 1. Platt relates to a storage device that performs a plurality of functions that produce a result that can be an input to the method of amended claim 1 of the instant application but which does not anticipate the claims at issue. Platt does not disclose the required mapping, generation of a key, or string the entry as required by amended claim 1.

The Examiner further says Platt et al. teaches storing descriptors of each molecule in a database for subsequent processing (col. 16 lines 4-7). That statement does not describe any of the claimed steps. The claimed step of "storing" relates to the entry defined in the first step. The section of Pratt cited has nothing to do with such an entry and hence cannot correspond to the claimed storing step, or any other claimed step.

The Examiner also argues that the "key" is inherent. Again, the claimed "key" corresponds to the claimed mapping and the Examiner has not shown anything in Platt corresponding to such a mapping. Instead, the Examiner argues that Platt has some criteria for selecting molecules of the training set to be placed in a table and that this corresponds to "applying the mapping." The Examiner does not show how the placement of molecules in a table relates even remotely to applying a mapping to a descriptor vector as claimed and has fallen far short of the exact relationship that anticipation requires.

The legal test for anticipation is whether every element of a claim is found in an item of prior art, and not whether a structure is consistent with a claimed method. Therefore, Applicant

respectfully requests withdrawal of the rejection of independent claim 1 under Section 102(a) and 102(e)(2).The Applicant respectfully requests withdrawal of the Examiner's rejection and allowance of this claim.

Further, dependant claims 4-15 and 31-35 depend from and include all of the limitations of independent claim 1. For this reason, the Applicant respectfully requests withdrawal of the Examiner's rejection and allowance of these claims.

For the foregoing reasons, Applicant respectfully requests entry of the amendment and allowance of the pending claims.

Respectfully submitted,


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